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CENTRAL FAX CENTER

OCT 27 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Haihong ZHENG
Application No. : 09/992,790
Filing Date : November 5, 2001
Examiner : Emmanuel Coffy
Group Art Unit : 2157
Title : APPARATUS, AND ASSOCIATED METHOD, FOR
FACILITATING QOS AND BEARER SETUP IN
AN IP-BASED COMMUNICATION SYSTEM
Attorney Docket No.: NOKIA.5003US

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW


Sir:

Applicant respectfully requests review of the final rejection in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheets (5 pages). I am the attorney or agent of record.

Respectfully submitted,



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Atty. Dkt. No. NOKIA.5003US

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**Obviousness Rejection - Claims 1-3 and 15-20**

The final Office Action dated July 27, 2006 rejects claims 1-3 and 15-20 as obvious over a combination of three patents (see part 6 on pages 5-10). The primary reference is the communication system having the call set-up process shown in Figs. 4a-6b and described in col. 3 of U.S. Patent No. 6,785,510 issued to Larsen (this communication system hereinafter referred to as "Larsen"). The second patent is U.S. Patent No. 6,266,695 issued to Huang et al and the third patent is U.S. Patent No. 6,765,912 issued to Vuong. Applicant respectfully submits that there is clear error in the Examiner's rejection of claims 1-3 and 15-20 because: 1) there is no teaching, suggestion or motivation to modify the primary reference (Larsen) to include the bearer manager client of the second patent (Huang); 2) the rejection uses hindsight to make the selective combination of parts; and 3) there is no teaching, suggestion or motivation to use the first bearer setup request generator of the third patent (Vuong) as proposed in the rejection.

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Independent claims 1 and 17 recite several features related to "facilitating bearer setup of a bearer between [a] communication node and [a] correspondent node through operation of a selected bearer manager, the selected bearer manager having a network address identifying a network location thereof". There are also recitations of "a first bearer setup request generator associated with [a] first application-level entity" in the communication network and generating a first bearer setup request which "when generated at the first application-level entity" is "free of the network address identifying the network location."

1) The primary reference (Larsen) is admitted in the rejection to lack these features, and the rejection relies upon the second patent (Huang) as including a bearer manager. Applicants argued in their Amendment filed on April 28, 2006 that there was no teaching or motivation to do so (see page 10, second full paragraph). The Examiner noted the argument (see part 4.a) on pages 2-3 of the final Office Action), responded to the argument with a form paragraph (Form Paragraph 7.37.04), and made the following statement:

"In this case, the Huang patent need not contain a teaching that would prompt one of ordinary skill in the art to seek to combine the bearer manager client with Larsen."

This statement is clearly contrary to applicable law. The resulting final rejection thus plainly fails to make out a prima facie case of obviousness and could not possibly be affirmed on appeal because it does not point out where there is any teaching or motivation to make the selective combination of references proposed in the rejection.

2) At part 4.b) on page 3, the final Office Action notes applicant's argument of hindsight, but merely cites a form paragraph acknowledging hindsight and does not deny that hindsight was used. Consideration of the two patents clearly reveals that the final rejection is the result of impermissible hindsight.

The primary reference (Larsen) is directed to a hybrid wireless system which combines conventional cellular technology with opportunistic technology for relaying data between mobile stations. The second patent (Huang) is directed to a telecommunications switch management system.

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The Background of the Invention section of Huang addresses conventional telecommunications switch management systems and points out the disadvantages of their dedicated Operational Support Systems ("OSSs") at col. 1, lines 27-48. The entire Huang patent is directed towards switch management systems, and makes absolutely no mention of cellular systems, wireless systems, much less the hybrid system of Larsen. What the Huang patent does though, is mention (at col. 10, lines 5-13, for example) the bearer manager recited in the claims and absent from Larsen. There would be no reason to look to this bearer manager in Huang except in an effort to find a bearer manager to be inserted into Larsen. In other words, the reliance upon the bearer manager in Huang is the result of impermissible hindsight in attempting to fashion a rejection of the claims.

3) The primary reference (Larsen) and second patent (Huang) are lacking the bearer setup request features recited in the claims. The rejection relies upon the bearer setup request generator in the third patent (Vuong) and asserts that it would be used to modify the bearer in the switching management system of Huang. Once again, the rejection points to a portion of the Vuong patent (col. 5, line 60, to col. 7, line 35) in which the missing features are discussed, but there is no teaching in the cited portion. The rejection fails to point to any teaching or motivation that Huang should be modified to include the bearer setup request generator detailed description of Vuong.

Applicant made these arguments in the Amendment filed on April 28, 2006 (see page 11, last paragraph). Indeed, applicant's arguments pointed out that the teaching of the Vuong patent is made at col. 2, lines 6-31. This teaching is not applicable to the bearer setup request generator. The final rejection did not directly respond to these arguments that there was not a sufficient teaching or motivation in the Vuong patent, but merely referred to the earlier comments made in part 4.a) with respect to applicant's first argument. See part 4.c) on pages 3-4 of the final Office Action. Those comments stated that the Huang patent need not contain a teaching, and presumably part 4.c) is intended to say that the Vuong patent need not contain a teaching. Nevertheless, the position of the Examiner is clearly contrary to applicable law and cannot be upheld on appeal.

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Dependent Claims 2 and 3

In addition to the above features recited in independent claims 1 and 17, dependent claims 2 and 3 and 17 recite further features related to an interaction and/or interoperability of application layer processes and entities and transport layer processes and entities, and specifically that the first bearer setup request generator forms a portion of the application level and the first bearer setup request is sent to the transport layer. Not only is there no teaching or motivation in Vuong to include these features in Larsen or Huong, these features are not even present in Vuong.

The rejection either relies upon col. 7, line 36, to col. 8, line 48, or col. 5, line 60, to col. 7, line 35, of the Vuong patent as going into "details of how a bearer setup request is processed." However, claims 2 and 3 do not recite how a bearer setup request is processed. They recite very particular features which are absent from Vuong.

Dependent claims 15 and 16

Claims 15 and 16 recite that the communication system includes a home network and a visited network, wherein the first application-level entity associated with the first bearer setup request generator comprises an application server in the home network or visited network, respectively. The obviousness rejection refers to various portions of the Vuong patent when rejecting these claims, however none of the cited portions disclose the recited features. The rejection further states that Vuong "would easily be integrated within the home office thus securing greater market share." However, it is not understood how this is relevant to the features recited in claims 15 and 16.

Applicant made these arguments in the Amendment filed on April 28, 2006 (see page 12). But the final Office Action does not respond to these arguments.

Obviousness Rejection - Claims 4-14

The final Office Action dated July 27, 2006 rejects claims 4-14 as set forth in part 7 on pages 10-15 of the Office Action. Specifically, in addition to the three references set forth in the rejection of

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claim 1, this rejection relies upon a fourth reference - U.S. Patent No. 6,714,515 issued to Marchand. Applicant respectfully submits that there is clear error in the Examiner's rejection of claims 4-14 because there is no teaching, suggestion or motivation to make the four way combination proposed in the rejection.

Applicant's arguments were made on page 13 of the Amendment filed on April 28, 2006 (see page 13). The final rejection did not directly respond to these arguments that there was not a sufficient teaching or motivation in Marchand, but merely referred to the earlier comments made in part 4.a) with respect to applicant's first argument. See part 4.e) on page 4 of the final Office Action. Those comments stated that the Huang patent need not contain a teaching, and presumably it is intended to say in part 4.e) that the Marchand need not contain a teaching. Nevertheless, the position of the Examiner is clearly contrary to applicable law and cannot be upheld on appeal.

Respectfully submitted,



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